

### REMARKS

In accordance with the foregoing, Claims 28-61 are pending in the application, Claims 28 and 38-59 being withdrawn and Claims 29-37, 60 and 61 are under consideration. Of Claims 29-37, 60 and 61, Claims 29 and 60 are independent. Claims 34 and 61 have been amended to correct typographical errors. No new matter is presented in this response. Favorable consideration of this application is respectfully requested in light of the following remarks.

Applicants gratefully acknowledge withdrawal of the 35 USC 112 rejection and withdrawal of the objection to the drawings.

#### ***Response to Arguments***

On page 3 of the Official Action, the Examiner states:

The applicant responded to the objection to the drawings by admitting on the record (see Remarks, 9/28/2007, page 18, lines 3-5) that the connections were conventional and need not be shown. Therefore, the examiner believes that the invention as claimed is obvious because it has been admitted on the record that one of ordinary skill would know how to connect the two machines.

The Applicants respectfully submit that the Applicants' remarks were taken out of context and that the Applicants are not admitting the connection between the combining machine and tipping machine is conventional. Applicants are merely stating that the output of the combiner to the link-up assembly need not be shown. A person of ordinary skill in the art has sufficient technical ability to engage the drum link-up assembly shown in FIG. 9 with the combiner in the manner shown in FIG. 15. FIG. 9 clearly shows the separator drum 232 of the drum link-up assembly connected to the assembly drum 238 of the tipping machine. FIG. 15 shows the

combining machine connected to the drum link-up assembly and the drum link-up assembly connected to the tipping apparatus. It is submitted that the connection between the drum link-up assembly to the combining machine is sufficiently illustrated in the drawings to allow a proper understanding of the disclosed invention, thereby complying with 37 CFR §1.83(a).

***Rejection under 35 U.S.C. §103(a):***

**Claim 29:**

The Official Action rejects Claim 29 under 35 U.S.C. §103(a) as allegedly unpatentable over what the Official Action terms "admitted prior art". The rejection is respectfully traversed for at least the following reasons.

As stated in the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International v. Teleflex Inc.*, 72 Fed. Reg. 57526 at 57528 (October 10, 2007), issued by the USPTO, the Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. For a proper obviousness rejection, the Patent Office must provide "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" and not "mere conclusory statements." KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 82 USPQ2d 1385, 1396 (2007) (quoting In re Kahn, 441 F.3d 977, 988, (Fed. Cir. 2006)). The Official Action does not identify a reason that would have prompted a person having ordinary skill in the art to make the claimed combination recited in independent Claim 29. In addition, as stated in MPEP §2143, to establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or

suggest all the claim features. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The combination of features cited by the Examiner does not teach or suggest all the claim features of Claim 29.

On page 6 of the Official Action, the Examiner states

Although a prior art means for connecting a cigarette making machine and a tipping machine is not disclosed, it would have been obvious to one of ordinary skill in the art at the time of invention to combine both machines.

However, Claim 29 recites, an apparatus comprising, *inter alia*, a drum link-up assembly adapted to transfer a tobacco rod from a combining apparatus to a tipping apparatus, and a laser perforating apparatus adapted to burn one or more holes in an outer surface of the tobacco rod while the tobacco rod is in the drum link-up assembly. At least because a drum link-up assembly is missing from the prior art, the Examiner has not articulated a reason why one having ordinary skill in the art would combine a previously unknown element, e.g., the drum link-up assembly, with another element such as the laser perforating apparatus.

Furthermore, as stated in the Official Action on page 6, the prior art does not disclose a laser perforation apparatus in a means for connecting a cigarette maker and a tipping machine. As Applicants stated in the previous response, since the prior art does not disclose a drum link-up assembly adapted to transfer a tobacco rod from a combining apparatus to a tipping apparatus, there is no reason one having ordinary skill in the art would have been motivated to combine a laser perforating apparatus with such a drum link-up assembly to burn one or more holes in an outer surface of the tobacco rod while the tobacco rod is in the drum link-up assembly as recited in Claim 29.

The Official Action states on page 6:

However, laser perforation apparatus' are well known in the art. In addition, it would have been obvious to include a laser perforation apparatus, which are known in the prior art, at any point along the cigarette making process, including in a connecting means between a cigarette making machine and a tipping machine.

The above quoted language is unsubstantiated by prior art references. For example, even if Dearsley (U.S. Patent No. 3,036,581) which is referred to on page 7 of the Official Action, has a connecting device, such a connecting device is not a drum link-up assembly. The Official Action even states on page 7, "prior art for using a drum to connect two different cigarette machines is not disclosed." Therefore, the combination cited by the Examiner does not provide all of the elements recited in Claim 29, at least because it is missing the drum link-up assembly.

Nichols et al. (U.S. Patent No. 4,570,649) merely discloses employing a laser perforation system to make perforations in tipping paper and plug wrap (col. 3, line 57 to col. 4, line 36). In contrast, Claim 29 recites a laser perforates a tobacco rod in combination with the tobacco rod in a drum link-up assembly. Therefore Nichols does not cure the deficiency in the prior art.

In the paragraph spanning pages 2 and 3 of the Official Action, the Examiner alleges that the Claimed subject matter recited in Claim 29 would have yielded predictable results or would have been obvious to try. As stated in the Examination Guidelines, 72 Fed. Reg. 57526 at 57529, the rationale to support a conclusion that the claim would have been obvious because of yielding predictable results includes determining that all of the claimed elements were known in the prior art. As discussed above, at least the drum link-up assembly is missing from the prior art. Similarly, to reject a claim based on obvious to try, the Office personnel must

articulate a finding that at the time of invention, there had been a recognized problem or need in the art, as well as a finding that there had been a finite number of identified, predictable potential solutions to the recognized need or problem.

Examination Guidelines, 72 Fed. Reg. 57526 at 57532. At least because the Examiner has not identified any recognized problem or need in the art, this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

Based on the foregoing, Claim 29 is patentable over the prior art cited in the Official Action. Applicants respectfully request withdrawal of the rejection and reconsideration of Claim 29.

**Claims 30-37 and 60-61:**

Claims 30-37 are considered patentable at least because they depend from Claim 29 which is patentable. As stated in MPEP §2143.03, if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly, Applicants respectfully request withdrawal of this ground of rejection.

Claim 60 is patentable for reasons similar to those put forth above with regard to Claim 29 and Claim 61 is patentable at least because it depends from Claim 60 which is patentable.

**Conclusion:**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

In the event that any additional fees are due with this paper, please charge our Deposit Account No. 02-4800.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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